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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/046,573 | 01/14/2002 | David P. Gallo SR. | 1242002A | 4971 |
| 7590 | 02/12/2004 | | EXAMINER | |
| Victor A. Cardona Heslin Rothenberg Farley & Mesiti P.C. 5 Columbia Circle Albany, NY 12203 | | | ROLLINS, ROSILAND STACIE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |
| DATE MAILED: 02/12/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/046,573 | GALLO, DAVID P. |
| | Examiner | Art Unit |
| | Rosiland S Kearney | 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 November 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Li (US 5575805). In column 6 line 19 through column 7 lines 13 Li discloses method of closing a pair of clamping arms of an endoscopic grasping tool surgical instrument, the pair of clamping arms being anchored to and within a tubular sheath in an opposed, normally open relation to one another and being of the type having jaws with distal tips and heels and having wrists proximal to the jaws, wherein the method comprises the steps of: urging the arms together so that they meet at their wrists while the jaws remain open; and then urging the jaws together so that they meet first at their distal tips and last at their heels.
2. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Lichtman (5620459). Lichtman discloses a method of ratcheting the closure of a pair of jaws of an endoscopic grasping tool surgical instrument comprising the steps of: providing a pivotally mounted actuator handle (14) operatively coupled to the jaws (2), the handle having a drive head (36) which moves distally to effect jaw closure and said drive head having teeth (71) formed thereon; and providing a pawl (73) positioned for engagement with the teeth so as to prevent proximal movement of the drive head

after it has moved distally (col. 9 lines 29-52).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichtman. Lichtman teaches all of the limitations of the claims except the pawl comprising two tines of unequal length. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second tine, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art.

4. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al. (US 5443463) further in view of Yoon (US 5665100). Stern et al. disclose a method of advancing a surgical cutter of an endoscopic grasping tool and the surgical instrument comprising: providing two pairs of clamping arms (figure 2a), the arms of each pair being disposed in opposed relation to each other; providing the surgical cutter (49) disposed between the pairs of arms and supported for reciprocating longitudinal movement between an advanced position in which the cutter occupies at least part of an envelope of space defined by and between two pairs of jaws of the pair of arms and a retractable position in which the cutter is proximal to the envelope.

Stern et al. teach all of the limitations of the claims except providing a handle having a drive head operable between a jaws open position and a jaws closed position; providing a drive rod having a distal end operatively coupled to the cutter and a proximal end in the handle; providing a drive plate operatively coupled to the distal end of the drive rod; moving the cutter to a cutter advanced position by moving the drive plate; and blocking movement of the cutter to the cutter advanced position by the drive head when the drive head is not in the jaws closed position.

Yoon discloses a similar device that includes a drive head, a drive rod (22) having a distal end operatively coupled to the cutter and a proximal end in the handle; a drive plate operatively coupled to the distal end of the drive rod and teaches that it is old and well known in the art to block movement of the cutter to the cutter advanced position by the drive head when the drive head is not in the jaws (col. 10 line 63 – col. 11 line 14). Yoon discloses the above mechanism and procedure as part of a safety feature of the device to prevent the apparatus from inadvertently cutting tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the safety mechanism disclosed by Yoon in the Stern et al. apparatus to prevent the device from inadvertently cutting tissue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is 703/3082711. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 703/3080994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
Art Unit 3739

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